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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,913	06/30/2000	Eduardo Cue	P2514/001580-569	1176

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EXAMINER
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RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/607,913	<b>Applicant(s)</b> CUE ET AL.	
	<b>Examiner</b> Rob Rhode	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30, 32 - 34, 36-38 & 40-44 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-30, 32 - 34, 36-38 & 40-44 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The applicant traversed the rejection for claims 1 – 30, 32 – 34, 36 – 38 and 40 – 44.

Currently claims 1 – 30, 32 – 34, 36 – 38 and 40 – 44 are pending.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1 – 30, 32 – 34, 36 – 38 and 40 – 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodd (US 6,633,849 B1) in view of “Will Gift Lists Click?” New York Times; New York, November 18, 1999 and hereafter referred to as “Wish Lists”.**

Regarding claim 1 and related claims 8, 15, 22, 29, 33, 37 and 41 (previously presented), Dodd teaches a method and system for automatically sending an order from a first user to a recipient over a computer network, the method comprising: receiving order selections from a computer of the first user; saving stored order data, the stored order data including the order selections and order purchase information; generating a web page having an address and containing the order selections and order purchase

information from the stored order data; and in response to a first user request, automatically producing and sending an electronic mail message having the address of the web page to a computer of the recipient and generated from the stored\_order data, the electronic mail message identifying the stored order and order purchase information and allowing the recipient to select the stored order using the web page wherein the stored order is not editable by the recipient and generating the web page and electronic mail message from the stored order data simplifies operation (see at least Abstract, Col 2, lines 23 – 40, Col 3, lines 30 – 55, Col 10, lines 33- 43 and Figure 5).

Please note that “the stored order data” such as “order selections and order purchase information” are considered to be non-functional descriptive material (MPEP 2106). For example, online methods and systems for transmitting and receiving “stored data” such as “order selections and order purchase information” such specifics of the transmitted stored data are given little patentable weight. The phrase(s) and or word(s) are given little patentable weight because the claim language limitation is considered to be non-functional descriptive material, which does not patentably distinguish the applicant’s invention from Dodd as well “Wish Lists”, which both disclose transmitting as well as receiving stored data. Thereby, the non-fictional descriptive material is directed only to the content of the data being transmitted and received (. i.e. order selections and order purchase information - which is stored data) and does not affect either the structure or method/process of Dodd as well as “Wish Lists”, which leaves the method(s) and system(s) unchanged. In this manner, the references disclose methods of transmitting, receiving and responding to transmitted “stored data”.

While Dodd does disclose the same method and system as recited in claim 1 as well disclosing gift certificates for use in purchasing, Dodd does not specifically disclose and teach purchasing.

On the other hand and in the same area of online ordering and recipient of stored data such as order selection and selection, Wish Lists does disclose and teach purchasing by the recipient (see at least Page 2, Para 2 and Para 7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method and system of Dodd with the method and system of Wish Lists to have enabled a method and system for automatically sending an order from a first user to a recipient over a computer network, the method comprising: receiving order selections from a computer of the first user; saving stored order data, the stored order data including the order selections and order purchase information; generating a web page having an address and containing the order selections and order purchase information from the stored order data; and in response to a first user request, automatically producing and sending an electronic mail message having the address of the web page to a computer of the recipient and generated from the stored\_order data, the electronic mail message identifying the stored order and order purchase information and allowing the recipient to purchase the stored order using the web page wherein the stored order is not editable by the recipient and generating the web page and electronic

mail message from the stored order data simplifies operation. Dodd discloses all the claim limitations with the exception of purchase (Abstract, Col 2, lines 23 – 40, Col 3, lines 30 – 55 and Figure 5). Wish List discloses purchase (Page 2). Therefore, one of ordinary skill in the art would have been motivated to extend the method and system of Dodd with a purchase feature. In this manner, the user satisfaction with the method and system will be increased as result of providing items that they want the recipient to purchase for them, especially distant relatives who are not familiar with the user's preferences.

Regarding claim 2 and related claims 9, 16 and 23 (Original), Wish Lists teaches a method and system, further comprising producing a display of the stored order for potential purchase by the recipient (Page 2)

Regarding claim 3 and related claims 10, 17 and 24 (Original), Wish Lists teaches a method and system, wherein the display-producing step comprises producing a web page display of the stored order for purchase by the recipient (Page 2)).

Regarding claim 4 and related claims 11, 20 and 28 (Original); Dodd teaches a method and system, wherein the electronic mail message includes a URL which allows for the construction of a web page displaying the stored order (Col 4, line 26 and lines 44 - 46).

Regarding claim 5 and related claims 12, 18 and 25 (Original), Dodd teaches a method and system, wherein the stored order includes a single item (see at least Col 4, lines 52 - 59).

Regarding claim 6 and related claims 13, 19 and 26 (Original), Dodd teaches a method and system, wherein the stored order includes a main item and at least one accessory (see at least Col 4, lines 52 - 53).

Regarding claim 7 and related claims 14, 21 and 27 (Original), Dodd teaches a method and system, wherein the step of receiving the order selections includes providing an electronic display of possible selections for the user (see at least Figures 1A – 2F).

Regarding claim 30 and related claims 34, 38 and 42 (Original), Dodd teaches a method and system, wherein the first and second order selections are selected from a web page from an electronic commerce site (see at least Abstract and Col 1, lines 34 - 51)

Regarding claim 32 and related claims 36, 40 and 44 (Previously Presented), Dodd teaches a method and system, wherein the display of a web page for the first or second orders includes a link to a display of the items of the first order and a display of the items of the second order (see at least Figures 1A-2F).

Regarding claim 43 (Previously Presented), Dodd teaches a method and system wherein the display of the first and second stored orders comprise a web page (see at least Figures 1A-2F).

### ***Response to Arguments***

Applicant's arguments filed 1-13-05 have been fully considered but they are not persuasive.

Applicant argues that there is no motivation to combine Dodd with "Wish List".

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case and as noted above, the problem to be solved as recited in the claims is the transmission, receipt and response to "stored data". In that regard, Dodd discloses a method and system for transmitting, receiving and responding to "stored data" including the use of certificate to be used as form of payment (Col 10, lines 33 – 43). In turn, "Wish Lists" discloses a method and system for transmitting, receiving and responding to "stored data" including purchase (Page 2, Para 7). Moreover, the references teach the use of email in



transmitting, receiving and responding to the stored data. Therefore, one of ordinary skill in the art would have been motivated to extend the method and system of Dodd with a method and system to include purchase. In this manner, the recipient can purchase the stored data and thereby allow them to complete a transaction and not have to wait for additional communicates to transpire between the first user and the recipient.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **571.272.6761**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **571.272.7159**.

Any response to this action should be mailed to:

***Commissioner for Patents***


***P.O. Box 1450***

**Alexandria, Va. 22313-1450**

Or faxed to:

**(703) 872-9306** [Official communications; including  
After Final communications labeled  
"Box AF"]

**571.273.8300** [Informal/Draft communications, labeled  
RER

  
Jeffrey A. Smith  
Primary Examiner